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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,650	11/21/2003	Ziad Zakaria	68208/2	9143

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CANADA

EXAMINER
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SIMITOSKI, MICHAEL J

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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06/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/717,650

Applicant(s)

ZAKARIA, ZIAD

Examiner

Michael J. Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/22/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The IDS of 4/22/2004 was received and considered.
2. Claims 1-3 are pending.

***Priority***

3. It is noted that this application appears to claim subject matter disclosed in prior Application No. 60/427,952, filed 11/21/2002. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where

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applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 1, the limitation "said information" (lines 3-4) lacks sufficient antecedent basis. For the purposes of this Office Action, "said information" is understood to read "said data", referring to the previously-recited "data indicative of a location of a device" in the claim.

b. Regarding claims 2 & 3, the claims recite "A device according to claim 1", however, claim 1 is directed to "An antitheft device" that has among other things a processor including "data indicative of a location of a device". Therefore, it is unclear which device claims 2-3 intend to modify. For the purposes of this action, "A device according" (line 1 of claims 2-3) is understood to read "An antitheft device according".

c. All claims rejected under 35 U.S.C. §102 and §103 are rejected as best understood.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,842,106 to Hughes et al. (**Hughes**).

Regarding claim 1, Hughes discloses an antitheft device (authenticator/reader, col. 6, lines 16-17 & col. 7, lines 59-65) for portable electronic equipment (RFID tag, Fig. 2, #44) comprising a microprocessor (processor, Fig. 2, #54) and a communication module (antenna, Fig. 2, #34) for connection to an external communication network (RF (radio frequency) network, Fig. 2, #30), said microprocessor including data (challenge from random number generator, col. 6, lines 19-29) indicative of a location of a device (challenge is used to confirm a device is in range, Fig. 3, col. 1, lines 30-34 & col. 8, lines 4-8), an output to provide said information to said communication module (antenna receives challenge, col. 6, lines 28-29) and a comparator (processor) to compare a response (challenge response) from said communication module (antenna receives challenge response and compares it to pre-calculated response, col. 6, lines 33-44) to a predetermined response (value computed by Authenticator/reader, col. 6, lines 42-44) and thereby determine whether said equipment is in a desired location (col. 7, line 59 – col. 8, line 6).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Hughes**, as applied to claim 1 above, in further view of U.S. Patent Application Publication 2003/0204739 to Ng et al. (**Ng**).

Regarding claim 3, Hughes lacks upon receipt of a response other than said predetermined response, utilizing additional data with said external communication network to indicate a theft. However, Ng teaches that RF mechanisms (§16) can be used to protect high valued items against theft (§16), such that a component database is maintained with identification of all components (§34) where the components are polled periodically (§37) to determine if they are in a certain location (§38) and in response, each component responds with an identifier (§40) and a tampering status (§§40-41), where, upon a tampering status being other than a predetermined response (predetermined response is a value that indicates no tampering, §41), a microprocessor (reader, §41) uses additional data (relevant information regarding details of the type of tampering, §41) with an external communication network (page to a representative via radio network, §42) to indicate a theft of said equipment (§42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hughes such that each RF tag responds also with a tampering indication and upon receipt of a signal indicating that a tampering has occurred (response other than a predetermined response), using additional data (details of the type of tampering) in the microprocessor (reader) with said external network (radio network) to indicate a theft of the equipment (page to representative). One of ordinary skill in the art would have been motivated to perform such a modification to protect the configuration of a digital cinema system, as taught by Ng (§8).

***Allowable Subject Matter***

10. Claims objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and amended to overcome any rejections under 35 U.S.C. §112 and/or claim objections indicated in this Office Action.

d. Regarding claim 2, the prior art of record fails to teach or disclose, either alone or in combination, wherein said data is a telephone number of a location and said predetermined response is a busy signal from an external communication network, in combination with the other elements of the claim.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

e. U.S. Patent 7,193,504 to Carrender et al. is cited for teaching sending a signal to proximity tags that respond accordingly, and the response is compared to determine if a single tag or multiple tags are responding.

f. U.S. Patent 5,243,652 to Teare et al. is cited for teaching transmitting position information from a remote mobile node to a central facility (over a network) where the position is compared to an acceptable signature, wherein when acceptable, a decryption key is provided to the remote mobile node.



- g. U.S. Patent Application Publication 2004/0056759 to Ungs is cited for teaching a portable device comprising a “tether” that sends a request to a network to respond; if a positive response is received, the device resents a time, if not, the device self-disables.
- h. U.S. Patent 5,729,596 to Reeder et al. is cited for teaching an apparatus that, when requesting a power up, can send a “Who am I” request to a security unit, which returns a unique ID (such as a caller ID telephone number) to the unit to determine if it is calling from the correct location.
- i. U.S. Patent 5,802,280 to Cotichini et al. is cited for teaching a computer device that calls a predetermined monitoring service and sends identifying indicia for the device; the monitoring service can determine the location of the device from the indicia.
- j. U.S. Patent 6,031,894 to Fleming, III is cited for teaching a computer device that checks for a dial tone, calls a predetermined “home” number of the owner and disconnects; the caller identification of the owner would display at the owner.

Specifically, Fleming discloses an embodiment with the following language (col. 4, lines 15-25):

“It may be optimal for the owner phone number to be the phone number that is associated with the telephone line to which the computer 100 is normally connected. Thus, when the location tracking program instructs the computer 100 to initiate a call to the owner phone number, the location tracking program 200 would receive a busy signal and terminate the call. If the computer 100 were to be connected to any other phone line the ANI information would appear on the ANI receiver 130, and the owner would disregard that information.”

This discloses dialing a telephone number and receiving a response as a busy signal. However, this does not disclose comparing the response to a predetermined response and thereby determine whether said equipment is in a desired location.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J. Simitoski/

May 29, 2007